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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/748,706 | 12/22/2000 | Mark S. Chee | A-66828-5/DJB/RMS/DCF | 4006 |

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EXAMINER

FORMAN, BETTY J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1634

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

919

Advisory Action

Application No.

09/748,706

Applicant(s)

CHEE ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 40-49.

Claim(s) withdrawn from consideration: 27-39.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


BJ Forman
Primary Examiner
Art Unit: 1634

Continuation of 2. NOTE:

1) The amendments to Claims 40 and 42 further define the "identifier binding ligand" as being "directly attached to the microsphere". This definition has not previously been considered. As such, the amendment would require further search and consideration.

2) Applicant points to page 7, lines 5-6; page 64, lines 21-22; page 65, lines 7-8 and figures 8-10 for support of the amendments to Claim 40 and 42. However, the cited passages have been reviewed and are provided below:

Page 7, lines 5-6: identifier binding ligands (IBLs) attached to the beads'

Page 64, lines 21-22: "a complementary sequence containing FRET dyes separated by a linker of varying lengths allows multiple codes to be generated (Figure 4A). As an example, Probe A and B are hybridized to a complementary sequence immobilized on a solid support".


Page 65, lines 7-8: "16 different beads are labeled by attaching 16 different unique oligos (IBLs) to each of 16 batches of beads

At most, the cited passages teach the identifier binding ligands are "attached" to the beads. The cited passages do not teach or describe a "directly attached" identifier binding ligand. Because the cited passages do not teach or describe the "directly attached" identifier binding ligand, the amendment potentially raises issues of new matter.

3) Furthermore, new Claim 50-51 have been added without cancellation of an equal number of claims.

For all of the above reasons, the amendments would require further search and consideration and therefore have not been entered.

Applicant's arguments have been reviewed. However, the arguments address the un-entered amendments and therefore are moot regarding the outstanding rejection.


BJ FORMAN, PH.D.
PRIMARY EXAMINER